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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARLOS A. KHANTZIS

Appeal 2009-003421
Application 10/800,233
Technology Center 3700

Decided: March 19, 2010

Before MICHAEL W. O'NEILL, STEFAN STAICOVICI, and
KEN B. BARRETT, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Carlos A. Khantzis (Appellant) seeks our review under 35 U.S.C.
§ 134 (2006) of the final rejection of claims 1-14 and 32-45. Appellant

canceled claims 15-31 and 46-62. We have jurisdiction under 35 U.S.C.
§ 6(b) (2006).

The Invention

The claimed invention is to a toe support system that permits a user to rest his or her toes on a deformable material.

Claim 41, reproduced below, is illustrative of the subject matter on appeal.

41. A foot wearing item to be worn on a foot, the foot wearing item including an insole against which the foot rests and having a front area over which the toes of the foot rest when the foot wearing item is worn, the improvement comprising:
 - a. a flexible and deformable material formed within the front area of the foot wearing item and aligned with the insole so that the flexible material is located beneath the toes of the foot when the foot wearing item is worn so that all five toes rest on the flexible material;
 - b. whereby the flexible material permits the toes to curl downward when a wearer of the wearing apparel is walking.

The Prior Art

The Examiner relies upon the following as evidence of unpatentability:

Krinsky	US 4,211,236	Jul. 8, 1980
Kawashima	US 4,557,060	Dec. 10, 1985
Ito	US 4,768,295	Sep. 6, 1988
McClelland	US 5,775,005	Jul. 7, 1998

The Rejections

The following Examiner's rejections are before us for review:

(1) Claims 4, 6, 7, 10, 11, 12, 35, 37, 38, 41, 42, and 43 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kawashima. *See* Ans. 3.

(2) Claims 10, 12, 13, 41, 43, and 44 are rejected under 35 U.S.C. § 102(b) as anticipated by Krinsky. *See* Ans. 3-4.

(3) Claims 11 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Krinsky. *See* Ans. 4-5.

(4) Claims 14 and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Krinsky in view of Official Notice. *See* Ans. 5.

(5) Claims 1-6, 8-14, 32-37, and 39-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Krinsky in view of Official Notice. *See* Ans. 5-7.

(6) Claims 1 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawashima in view of Ito. *See* Ans. 7.

(7) Claims 5 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawashima. *See* Ans. 7.

(8) "Claims 2, 33 and 8, 13, 39, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1, 32 and 4, 10, 35, 41, respectively above, and further in view of US 5775005 (McClelland)." Ans. 8.

(9) "Claims 3, 34 and 9, 14, 40, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1, 32 and 4, 10, 35, 41, respectively above, and further in view of Official Notice." Ans. 8.

SUMMARY OF DECISION

We AFFIRM.

OPINION

Rejection (1) – Anticipation based on Kawashima

Since Appellant does not separately argue claims 4, 6, 7, 10, 11, 12, 35, 37, 38, 41, 42, and 43 for this ground of rejection as set forth by the Examiner, claim 41 is selected as the representative claim. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Based on Appellant's contentions, no error appears present in the Examiner's finding that claim 41 lacks novelty. Arguing that the Examiner erred because the figures of Appellant and Kawashima are different is unconvincing because what matters is what the claims recite vis-à-vis what Kawashima describes. As stated by our reviewing court in *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998), "the name of the game is the claim." If Kawashima describes the claimed subject matter, then Kawashima anticipates the claim. Arguing that anticipation is a three prong test with an identity component is unconvincing to show error on the Examiner's part. Anticipation is not an *ipsissimis verbis* test. *In re Bond* 910 F.2d 831, 832 (Fed. Cir. 1990). A single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Here, the Examiner made several findings regarding Kawashima's disclosure, and ultimately found that Kawashima anticipates claim 41. Final Rej. 2; Ans. 3, 9-10. Therefore, it is incumbent upon Appellant to particularly point out

what claim limitations are missing within Kawashima's description. *See Ex parte Frye*,¹ 2009-006013 (BPAI February 26, 2010) (precedential).

Appellant argues since Kawashima has two regions of cushioning Kawashima does not anticipate one region of cushioning. This argument is unconvincing to show error because the transitional phrase "improvement comprising" recited in claim 41 is open-ended and, as such, does not exclude additional, unrecited elements such as more than one cushion, projections, notches, and the like. *See Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim).

Arguing there is a difference in purpose between Appellant's cushioning vis-à-vis Kawashima's cushioning is unconvincing to show error in the anticipation rejection as well. What matters is not the purpose of the invention, but the objective reach of the claim. *Cf. In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) ("It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.")

Likewise, focusing on Kawashima's claims to demonstrate that Kawashima does not anticipate the claimed invention is unconvincing, because a patent is valuable for all it teaches to one of ordinary skill in the art. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968). It is well-settled that the use of patents as prior art references is not limited to what the patentees claim as their own inventions. They are relevant for *all* they contain. *In re Heck*, 699 F.2d 1331, 1332-33 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397

¹ <http://www.uspto.gov/ip/boards/bpai/decisions/prec/fd09006013.pdf>

F.2d 1006, 1009 (CCPA 1968)). A patent's claims determine what infringes the patent, not what the patent discloses. *In re Benno*, 768 F.2d 1340, 1346 (Fed. Cir. 1985).

Moreover, Kawashima's intentions for its cushioning or its manner of retaining the toe cushion are not germane as to whether Kawashima's description anticipates claim 41, because it is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. *See Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983). In this case, the Examiner found that claim 41 reads on certain aspects of Kawashima's description.

Regarding the aspect of the figures showing a deformable gel vis-à-vis claim 41, claim 41 is not limited to a gel, it is limited to a flexible and deformable material which the Examiner finds to be anticipated by Kawashima. As such, the argument is not commensurate with the scope of claim 41. On page 1 of the Reply Brief, Appellant asserts that the deformable padding of claim 4 is "comparable" to the deformable gel of claim 1. Even if this were to be construed as a separate argument for claim 4, the argument also is not commensurate with the scope of the rejected claim – claim 4 is not limited to a deformable gel and claim 1 is not subject to this first rejection.

Kawashima's ability to be used inverted as shown in figure 5 does not prohibit Kawashima from anticipating claim 41. Figure 4 of Kawashima depicts the cushion 4 located in a region for the toes to rest as set forth in claim 41.

Further, claim 41 is not limited to having a deformable padding the entire depth of the insole. Again, the claim recites a flexible and deformable material formed within the front area of the foot wearing item, and the Examiner found that Kawashima anticipates such a feature. As such, Appellant's arguments directed to such matters regarding depth are not commensurate with the scope of claim 41.²

Moreover, how an apparatus invention is used is not germane to whether it is anticipated by the prior art for the subject matter of an apparatus claim must be distinguished from the prior art in terms of structure in order to avoid anticipation. *Ex Parte Masham*, 2 USPQ2d 1647, 1648 (BPAI 1987).

For the foregoing reasons, the Examiner did not err in rejecting claim 41 as anticipated by Kawashima. Claims 4, 6, 7, 10, 11, 12, 35, 37, 38, 42, and 43 fall with claim 41. 37 C.F.R. § 41.37(c)(1)(vii).

Rejection (2) – Anticipation based on Krinsky

Since Appellant does not separately argue claims 10, 12, 13, 41, 43, and 44 for this ground of rejection as set forth by the Examiner, claim 41 is selected as the representative claim. 37 C.F.R. § 41.37(c)(1)(vii).

Many of Appellant's arguments are essentially repetitive of what Appellant argued against the anticipation rejection based on Kawashima. As such, the reasons given *supra* why these arguments fail to note an error on the Examiner's part are applicable and are incorporated herein. What Krinsky claims and depicts in its figures; comparison of Krinsky's figures to

² Appellant misquotes the Examiner's Answer and suggests that the Examiner ignored the recitation in claim 4 of padding location language similar to that of claim 41. Reply Br. 2. The Examiner correctly noted that the claim does not limit the location to *only* under the toes. Ans. 9.

Appellant's figures; stating that the law requires identity to establish anticipation; alleged physical differences between Appellant's disclosed embodiments and Krinsky's figures; what Krinsky teaches and that being different from what Appellant's disclosure teaches; any difference in Krinsky's intentions vis-à-vis Appellant's intentions; Appellant's limited applicability to the toe region compared to Krinsky when the Appellant's claim contains an open-ended transition phrase; Appellant's claimed invention's capability compared to Krinsky's capability when the claimed invention is directed to an apparatus; and Krinsky's foot wearing item having more features than the claimed invention when the claimed invention contains an open-ended transitional phrase, are unconvincing to demonstrate the Examiner erred in rejecting claim 41 as anticipated by Krinsky for the same reasoning as given *supra* regarding no error on the part of the Examiner for rejecting claim 41 as anticipated by Kawashima.

For the foregoing reasons, the Examiner did not err in rejecting claim 41 as anticipated by Krinsky. Claims 10, 12, 13, 43, and 44 fall with claim 41. 37 C.F.R. § 41.37(c)(1)(vii).

Rejection (3) – Obviousness based on Krinsky

In setting forth the rejection of claims 11 and 42, the Examiner concludes that to have one of the listed materials as the viscous material described in Krinsky would be obvious to a person of ordinary skill in the art "since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice." Ans. 4-5.

The Examiner's belief that *In re Leshin*, 277 F.2d. 197 (CCPA 1960) stands for the proposition stated in the Answer turns the holding of *Leshin*

on its head. The court in *Leshin* concluded that the mere selection of known plastics to make a known metal container of plastic based on the suitability of the plastic for the intended use was obvious to a person having ordinary skill in the art because the Anderson reference taught a similar container made from plastic. *Id.* at 199. In other words, there was prior art that evidenced using a suitable plastic for the intended use of the claimed invention.

Taking the proposition in the Answer to its logical conclusion, when the only difference between the scope and content of the prior art and the claimed invention is the material used, the claimed invention is *per se* obvious. However, as stated in *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995):

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention—including all its limitations—with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO Examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention *as claimed* in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any rules of

obviousness, just as those precedents themselves expressly declined to create such rules.

As the court further noted, “[a]ny conflicts as may be perceived to exist derive from an impermissible effort to extract *per se* rules from decisions that disavow precisely such extraction.” *Id.* In other words, cases like *Leshin* are limited to the specific facts of that case and are not to be extrapolated to general rules stating that claimed features are automatically obvious to persons of ordinary skill in the art without some foundation of evidence and/or analysis to support such a conclusion.

For the foregoing reasons, the Examiner erred in rejecting claims 11 and 42 as being obvious.

Rejection (4) – Obviousness based on Krinsky in view of Official Notice

Since Appellant does not separately argue claims 14 and 45 for this ground of rejection as set forth by the Examiner, claim 45 is selected as the representative claim. 37 C.F.R. § 41.37(c)(1)(vii).

Claim 45 further limits claim 41 to having the flexible and deformable material treated with a fungicide. The Examiner took official notice that use of fungicide is old and well known. Appellant does not challenge the notice. Therefore, the Examiner’s official notice is taken as an admission on Appellant’s part. Appellant, instead, argues essentially what Appellant argued regarding the anticipation rejection based on Krinsky. Inasmuch as those arguments do not show error on the part of the Examiner they further do not show error in the Examiner’s conclusion of obviousness with respect to claim 45. As such, Appellant has failed to demonstrate either by argument and/or evidence that the Examiner made an error in either (1) an underlying finding of fact upon which the final conclusion of obviousness was based, or (2) the reasoning used to reach the legal conclusion of

obviousness. Moreover, Appellant has not submitted evidence of secondary considerations of non-obviousness for consideration to weigh against the Examiner's legal conclusion of obviousness.

For the foregoing reasons, the Examiner did not err in rejecting claims 14 and 45 as being obvious.

Rejection (5) – Obviousness based on Krinsky in view of Official Notice

The Examiner's lack of discussion of Krinsky in light of the case law does not show error on the Examiner's part and is in fact innocuous.

In setting forth a prima facie case of obviousness, the Examiner needs to determine the scope and content of the prior art, acknowledge any differences, if needed, resolve the level of ordinary skill, and, if presented, take into account any secondary considerations. With respect to claims 10, 12-14, 41, and 43-45, it appears the Examiner has followed the proper procedures for making an obviousness rejection so as to put Appellant on notice of the reasons why the Appellant is not entitled to a patent on the claim scope that Appellant seeks.

However, concerning claims 1-6, 8, 9, 11, 32-37, 39, 40, and 42, the Examiner again relied on an improper understanding of *Leshin*, stating "since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice" as support for the conclusion that it would have been obvious to use a gel or gel-like material as set forth in claims 1, 4, 11, 32, 35, and 42 as the viscous material within Krinsky. *Per se* rules directed to the alleged obviousness of a claimed invention are looked upon with disfavor. See *In re Ochiai*, 71 F.3d at 1572 (reliance on *per se* rules of obviousness that eliminate the need for fact-specific analysis

of claims and prior art is legally incorrect). As such, the Examiner erred in rejecting claims 1, 4, 11, 32, 35, and 42 as obvious. Claims 2, 3, 5, 6, 8, 9, 33, 34, 36, 37, 39, and 40 are likewise erroneously rejected based on the Examiner's reliance on a *per se* rule of obviousness. See *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim dependent therefrom is nonobvious). Accordingly, the Examiner erred in rejecting these claims as obvious within this ground of rejection.

Regarding claims 10, 12-14, 41, and 43-45, no *per se* rule of obviousness was applied by the Examiner. As such, it is now incumbent upon Appellant to either submit argument and/or evidence to show that the Examiner made an error in either (1) an underlying finding of fact upon which the final conclusion of obviousness was based, or (2) the reasoning used to reach the conclusion of obviousness; or submit evidence of secondary considerations of non-obviousness. However, Appellant does not challenge the Examiner's particular findings, or cogently explain why they are insufficient to establish that the combined teachings of the references render obvious the claimed subject matter. Instead, Appellant merely points out what is disclosed as the Appellant's invention and alleges that the references do not describe exactly these features. In view of the particular findings of the Examiner for these claims, Appellant's mere allegations are not persuasive. See *Ex parte Belinne*,³ 2009-004693, slip op. at 7, 8 (BPAI Aug. 10, 2009) (designated as an "Informative Opinion"), (citing 37 C.F.R. § 41.37 (c)(I)(vii) (2007)). Moreover, many of the arguments have been addressed substantively *supra* concerning Krinsky anticipating claim 41.

³ <http://www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf>

Since Appellant does not separately argue claims for this ground of rejection as set forth by the Examiner, claim 41 is selected as the representative claim for claims 10, 12-14, and 43-45 and since no error has been shown by Appellant regarding claim 41, these claims fall as well. 37 C.F.R. § 41.37(c)(1)(vii).

In view of the foregoing, the Examiner did not err in rejecting claims 10, 12-14, and 43-45 as obvious under this ground of rejection.

Rejection (6) – Obviousness based on Kawashima in view of Ito

Since Appellant does not separately argue claims 1 and 32 for this ground of rejection as set forth by the Examiner, claim 32 is selected as the representative claim. 37 C.F.R. § 41.37(c)(1)(vii).

Notwithstanding Appellant's listing of statements attributed to various courts, a combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR Int'l.*, 550 U.S. at 416. A prima facie conclusion of obviousness may be supported by a showing that the claims are directed to a process, machine, manufacture, or composition of matter already known in the prior art that is altered by the mere substitution of one element for another known in the field, and such modification yields a predictable result. *See id.* (citing *United States v. Adams*, 383 U.S. 39, 50-51 (1966)). The Court further stated that, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR Int'l.*, 550 U.S. at 417.

The Examiner found Kawashima discloses a footwear item as set forth in claim 32 sans the cushioning material constituting a gel. The Examiner

found Ito teaches the cushioning material constituting a gel. The Examiner further found Ito teaches that using this gel facilitates absorbing shock instantly. Ans. 7. As such, modifying the cushioning material in Kawashima to be made of the gel material taught in Ito appears to be nothing more than applying a technique used to improve the usability of one device and improving a similar device in the same way, which involves nothing more than ordinary creativity well within the technical grasp of a person of ordinary skill in the art. *See KSR Int'l*, 550 U.S. at 417.

Appellant's arguments regarding why Ito is completely different from the present invention appear to opine that Ito teaches away. These arguments are not persuasive because in order to "teach away" a reference must "criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Ito's purpose of providing both cushioning and lateral support for sport shoes does not show that Ito teaches away because "familiar items may have obvious uses beyond their primary purposes." *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007) (citations omitted).

Moreover, in making a determination with regard to obviousness, the inquiry is not limited to looking only at the problem Appellant was trying to solve. The question is not whether the combination was obvious to Appellant but whether it was obvious to a person of ordinary skill in the art. Thus, "[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l*, 550 U.S. at 420. Ito describing more structure than set forth in the claim is unconvincing to show error because the transitional phrase of the claim is

open-ended and does not exclude additional, unrecited elements such as more than one cushion, channels, grooves, chambers, and the like. *See Genentech, Inc.*, 112 F.3d at 501.

With respect to Appellant's contentions against Kawashima, these contentions are similar to the contentions Appellant raised against Kawashima anticipating the claimed subject matter, i.e., what Kawashima claims and depicts in its figures; comparison of Kawashima's figures to Appellant's figures; requiring identity to establish unpatentability; alleged physical differences between Appellant's disclosed invention and Kawashima's figures; what Kawashima teaches and that being different to what Appellant's disclosed invention teaches; differences in Kawashima's intentions vis-à-vis Appellant's intentions; Appellant's limited applicability to the toe region compared to Kawashima when the Appellant's claim contains an open-ended transition phrase; Appellant's claimed invention capability compared to Kawashima's capability when the claimed invention is directed to an apparatus; and Kawashima's foot wearing item having more features than the claimed invention when the claimed invention contains an open-ended transitional phrase. These contentions are unconvincing to demonstrate that the Examiner erred in rejecting claim 32 as obvious over Kawashima and Ito for the same reasoning given *supra* regarding no error on the part of the Examiner for rejecting claims as anticipated by Kawashima.

For the foregoing reasons, the Examiner did not err in rejecting claim 32 as obvious given the combined teachings of Kawashima and Ito. Claim 1 falls with claim 32. 37 C.F.R. § 41.37(c)(1)(vii).

Rejection (7) – Obviousness based on Kawashima

Since Appellant does not separately argue claims 5 and 36 for this ground of rejection as set forth by the Examiner, claim 36 is selected as the representative claim. 37 C.F.R. § 41.37(c)(1)(vii).

Claim 36 further requires the deformable padding to be a thickness of at least 6 mm. The Examiner concluded that having a thickness of Kawashima's padding of at least 6 mm would be an obvious design choice dependent upon certain particular factors. Appellant does not specifically challenge that the Examiner's conclusion of having Kawashima's padding at least 6 mm thick would be an obvious design choice dependent upon the factors stated by the Examiner. Instead, Appellant argues that the thickness of Kawashima's cushion padding is less than 6 mm because Kawashima's figures 4 and 5 appear to depict the padding as very thin. However, patent drawings not designated as being drawn to scale cannot be relied upon to define precise proportions of elements if the specification is completely silent on the issue. *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000). As such, Appellant's reliance on Kawashima is unconvincing to highlight an error on the Examiner's part. Addressing Appellant's contention of the impossibility of a wearer's foot fitting inside Kawashima's shoe having a padding at least 6 mm thick, "a person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR Int'l*, 550 U.S. at 421. Accordingly, a person of ordinary skill could readily modify the shoe in order to accommodate the thickness of the padding being at least 6 mm thick.

For the foregoing reasons, the Examiner did not err in rejecting claim 36 as obvious given Kawashima. Claim 5 falls with claim 36. 37 C.F.R. § 41.37(c)(1)(vii).

Rejection (8) – Obviousness based on Kawashima and McClelland

Appellant appears to identify “Rejection (8)” *supra* as set forth in the Answer on page 8 as the Examiner rejecting these claims as obvious over Kawashima in view of McClelland. Since it is Appellant that seeks review of an adverse decision of the Examiner, the rejection set forth by the Examiner will be reviewed as to whether the Examiner erred in rejecting these claims as obvious based on the combined teachings of Kawashima (as applied to claims 4, 10, 35 and 41) and McClelland and the combined teachings of Kawashima and Ito (as applied to claims 1 and 32) and McClelland. Since Appellant does not separately argue claims 2, 8, 13, 33, 39, and 44 for this ground of rejection as set forth by the Examiner, claim 44 is selected as the representative claim. 37 C.F.R. § 41.37(c)(1)(vii).

Again, notwithstanding Appellant’s listing of statements attributed to various courts, the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR Int’l.*, 550 U.S. at 416. A *prima facie* conclusion of obviousness may be supported by a showing that the claims are directed to an apparatus already known in the prior art that is altered by the mere substitution of one element for another known in the field, and such modification yields a predictable result. *See id.* (citing *United States v. Adams*, 383 U.S. 39, 50-51 (1966)). The Court further stated that, “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR Int’l.*, 550 U.S. at 417.

Claim 44 requires the flexible and deformable material to be covered with a covering material. The Examiner found McClelland teaches providing a covering material for covering an insole. The Examiner reasoned that a person having ordinary skill in the art would combine the covering material with Kawashima's cushion in order to provide additional comfort to the wearer. The Examiner's reasoning has a rational underpinning because a person having ordinary skill in the art could readily improve Kawashima's cushioning with a covering since such a technique has not been shown to be beyond the skill of an artisan.

Appellant's contentions comparing McClelland's disclosure to Appellant's disclosure and differentiating McClelland's and Appellant's inventions by focusing on the fact that Appellant's invention has less structure and different purposes for the cushioning, are unconvincing to highlight an error on the Examiner's part in rejecting claim 44 for the following reasons.

McClelland describing more structure than set forth in the claim is unconvincing to show error because the transitional phrase of the claim is open-ended and does not exclude additional, unrecited elements such as more than one cushion, grooves, cheeks, and the like. *See Genentech, Inc.*, 112 F.3d at 501.

Appellant's argument that McClelland is completely different from the present invention appears to opine that McClelland teaches away. This argument is not persuasive because in order to "teach away" a reference must "criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). McClelland providing cushioning with the ability to view the cushion to observe any defect does

not show Ito teaches away because “familiar items may have obvious uses beyond their primary purposes.” *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007) (citations omitted). Moreover, in making a determination with regard to obviousness, the inquiry is not limited to looking only at the problem Appellant was trying to solve. The question is not whether the combination was obvious to Appellant but whether it was obvious to a person of ordinary skill in the art. Thus, “[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR Int’l.*, 550 U.S. at 420.

Appellant’s argument that McClelland’s scope and content lies outside that of the present invention could be considered an argument that McClelland is non-analogous art. “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re ICON Health & Fitness, Inc.*, 496 F.3d at 1379-80. McClelland is directed to footwear soles. It seems that a reference directed to footwear soles would logically commend itself to an inventor’s attention when considering the problem of improving a foot wearing item to be worn on a foot as has been set forth in dependent claim 44, which incorporates the limitations of independent claim 41. Therefore, McClelland lies within the scope and content of art to be considered and is not non-analogous.

For the foregoing reasons, the Examiner did not err in rejecting claim 44 as obvious over Kawashima in view of McClelland. Claims 2, 8, 13, 33, and 39 fall with claim 44. 37 C.F.R. § 41.37(c)(1)(vii).

Rejection (9) – Obviousness based on the prior art and official notice

An Appellant requests the Board to review the Examiner's adverse decisions. *See* 35 U.S.C. § 134(a). The Appellant has not separately argued claims 3, 9, 14, 34, 40, and 45 for the ground of rejection set forth in the Answer on page 8. As such, claim 45 is selected as the representative claim.

Claim 45 is dependent upon claim 41. As stated *supra*, the Examiner did not error in rejecting claim 41 as anticipated by either Kawashima or Krinsky. Claim 45 requires the flexible and deformable material to be treated with a fungicide. The Examiner took official notice that use of fungicide with shoe pads, cushions, and insoles is old and well known. Ans. 8. Appellant does not challenge the notice. Therefore, the Examiner's official notice is taken as an admission on Appellant's part. Appellant, instead, argues essentially what Appellant argued regarding the anticipation and obviousness rejections based on Kawashima and Krinsky. Inasmuch as those arguments do not show error on the part of the Examiner they further do not show error in the Examiner's conclusion of obviousness with respect to claim 45.

Further, Appellant does not challenge the Examiner's particular findings, or cogently explain why they are insufficient to establish that the combined teachings of the references render obvious the claimed subject matter. Instead, Appellant merely points out what is disclosed as the Appellant's invention and alleges that the references do not describe exactly these features. In view of the particular findings of the Examiner for these

claims, Appellant's mere allegations are not persuasive. As such, Appellant has failed to demonstrate either by argument and/or evidence that the Examiner made an error in either (1) an underlying finding of fact upon which the final conclusion of obviousness was based, or (2) the reasoning used to reach the legal conclusion of obviousness. Moreover, Appellant has not submitted evidence of secondary considerations of non-obviousness for consideration to weigh against the Examiner's legal conclusion of obviousness.

CONCLUSION

We have considered Appellant's remaining arguments in the Appeal Brief and Reply Brief, but do not find them persuasive to demonstrate error in the Examiner's conclusions of anticipation and obviousness other than what is articulated above. Therefore, we conclude that, but for the Examiner utilizing a *per se* rule of obviousness for particular claims designated *supra*, the Examiner did not otherwise err in rejecting the claims for lack of novelty and want of nonobviousness.

DECISION

The Examiner's decision to reject claims 4, 6, 7, 10, 11, 12, 35, 37, 38, 41, 42, and 43 under 35 U.S.C. § 102(b) as being anticipated by Kawashima is affirmed.

The Examiner's decision to reject claims 10, 12, 13, 41, 43, and 44 under 35 U.S.C. § 102(b) as anticipated by Krinsky is affirmed.

The Examiner's decision to reject claims 11 and 42 under 35 U.S.C. § 103(a) as being unpatentable over Krinsky is reversed.

The Examiner's decision to reject claims 14 and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Krinsky in view of Official Notice is affirmed.

The Examiner's decision to reject claims 10, 12-14, 41, and 43-45 under 35 U.S.C. § 103(a) as being unpatentable over Krinsky in view of Official Notice is affirmed; however, under the same ground of rejection as set forth in the Answer on pages 5 through 7 the Examiner's decision to reject claims 1-6, 8, 9, 11, 32-37, 39, 40, and 42 is reversed.

The Examiner's decision to reject claims 1 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima in view of Ito is affirmed.

The Examiner's decision to reject claims 5 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima is affirmed.

The Examiner's stated rejection of "[c]laims 2, 33 and 8, 13, 39, 44 ... under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1, 32 and 4, 10, 35, 41, respectively above, and further in view of US 5775005 (McClelland)," (Ans. 8) as argued by Appellant is affirmed.

The Examiner's stated rejection of "[c]laims 3, 34 and 9, 14, 40, 45 ... under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1, 32 and 4, 10, 35, 41, respectively above, and further in view of Official Notice," (Ans. 8) as argued by Appellant is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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Application 10/800,233

mls

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